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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,473	09/26/2001	Terry A. Guinan	P1046 US	2802
7590	09/21/2005		EXAMINER	
Medtronic AVE, Inc. 3576 Unocal Place Santa Rosa, CA 95403			BAXTER, JESSICA R	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Tatum

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/965,473	GUINAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jessica R. Baxter	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 July 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 30 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)  
 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_.  
 4)  Interview Summary (PTO-413)  
     Paper No(s)/Mail Date \_\_\_\_\_.  
 5)  Notice of Informal Patent Application (PTO-152)  
 6)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 5, 2005 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 6-11, 14-17, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,293,959 to Miller et al.

Miller discloses a balloon adapted to be mounted on a catheter (14) and to receive a stent (24) having proximal and distal ends, the balloon comprising: proximal and distal cones (FIG. 13), proximal and distal ends, respectively adjacent to the proximal and distal cones, and adapted for being mounted to the catheter, an intermediate body between the proximal and distal cones and configured to receive a stent thereon, the intermediate body having a proximal region configured to receive the stent proximal end, and a distal region configured to receive the stent distal end, and at least one circumferential groove (grooves formed by

stent, FIG. 15) formed on the balloon wall between one of the intermediate body proximal and distal regions and the proximal and distal cone; wherein said at least one circumferential groove is present when the balloon is in an inflated state and a deflated state (Column 5, line 41-Column 6, line 18), and said at least one circumferential groove has a smaller diameter than that of the intermediate body, and that of the respective cone, when the balloon is in an inflated state.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 5, 12, 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. '959 in view of U.S. Patent No. 6,254,608 to Solar.

Miller discloses the claimed invention except for the flexible material comprising a foamed material. Solar teaches that a foamed material is used for bonding the stent to the catheter to allow the stent to become embedded in the balloon in order to protect the anatomical passageways during delivery of the stent and prevent the stent from slipping without the use of a protective sheath (Column 3 line 44 – Column 4 line 2 and Column 5 lines 20-24). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the balloon catheter of Miller with the foamed material of Solar in order to protect the anatomical passageways during stent delivery and prevent the stent from slipping off the balloon without the use of a protective sheath.

***Response to Arguments***

6. Applicant's arguments filed July 5, 2005 have been fully considered but they are not persuasive.
7. Applicant argues that Miller et al. fails to teach a groove that is present in both the inflated and deflated states. However, Miller teaches that the balloon is heated with the stent crimped around the circumference. The heat will cause the balloon to permanently deform to include grooves to accommodate the stent (Column 5, line 41-Column 6, line 18). These grooves will be present before and after inflation of the balloon. Therefore, the rejection over Miller et al. '959 is proper.
8. Applicant argues that Solar does not teach grooves. Solar was not applied to teach grooves, Solar was applied to teach the use of foam to secure a stent to the balloon. The rejection over Miller et al. '959 in view of Solar '608 is still deemed proper.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R. Baxter whose telephone number is 571-272-4691. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica R Baxter  
Examiner  
Art Unit 3731

jrb



EDUARDO C. ROBERT  
PRIMARY EXAMINER